C. REMARKS

1. Summary of the Claims

Claims 1-20 are currently pending in the application. Claims 1, 8, and 14 are independent claims. Claims 1, 2, 5, 6, 8, 9, 12-15, 18, and 19 have been amended. Claims 4, 11, and 17 have been cancelled. No claims have been added. No new matter has been added. Reconsideration of the claims is respectfully requested.

2. Examiner Interview

Applicant notes with appreciation the telephonic interview conducted between Applicant's patent agent, Scott Schmok, Applicant's patent attorney, Leslie Van Leeuween, the Examiner, and the Primary Examiner, John Chavis, on January 11, 2005. During the telephonic interview, the Examiner, the Primary Examiner, and Applicant's patent agent discussed the 103 references (Hornibrook, et al., U.S. Patent No. 6,615,222 and Young et al., U.S. Pub. No. 2003/028,555). In particular, Applicant's patent agent pointed out that Hornibrook, which was used to reject Applicant's claim 4, is not prior art to Applicant's application pursuant to 35 U.S.C. § 103(c).

As for Young, Applicant's patent agent informed the Examiner and the Primary Examiner that Applicant completed and reduced to practice Applicant's claimed invention before the filing date of Young, and a declaration, pursuant to 37 C.F.R. § 1.131, would be filed to remove the Young reference. Furthermore, Applicant's patent agent proposed including the limitations of dependent claim 4 into the independent claims in order to read over the art of record. The Examiner and the

Primary Examiner agreed that the proposed amended claims would read over the art of record. Applicant has made such amendments to independent claims 1, 8, and 14 in this Response.

3. Drawings

Applicant notes that the Examiner did not indicate whether the formal drawings, filed with Applicant's application, are accepted by the Examiner. Applicant respectfully requests that the Examiner indicate whether the formal drawings are accepted in the next office communication.

4. Claim Rejections 35 U.S.C. § 101

Claims 1-7 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicants have amended claims 1-7 to include the words "computer implemented" in the preamble in order to address the rejection. In light of these amendments, Applicants respectfully request the withdrawal of the 35 U.S.C. § 101 rejections.

5. Claim Rejections 35 U.S.C. § 112

Claims 2, 6, 9, 13, 15, and 19 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 2, 6, 9, 13, 15, and 19 in order to correct the insufficient antecedent basis issues that are pointed out in the Office Action. Therefore, in light of

these amendments, Applicant respectfully requests the Examiner withdraw the 35 U.S.C. § 112 rejections based upon the claims as amended.

6. Claim Rejections 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)

Isip in view of Hornibrook

Claims 1, 7, 8, 14, and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Isip (U.S. Pat. No. 6,189,010, hereinafter "Isip"). Applicant respectfully traverses these rejections.

As discussed in the Examiner interview section above, Applicant has included the limitations of original dependent claims 4, 11, and 17 into independent claims 1, 8, and 14, respectively. The Office Action used Isip in view of Hornibrook, et al. (U.S. Patent No. 6,615,222, hereinafter "Hornibrook") to reject Applicant's original dependent claims 4, 11, and 17, which included the limitation of "copying an actual database, the copying resulting in an erroneous database."

The independent claims as amended are directed to "processing database code" with limitations comprising:

- copying an actual database, the copying resulting in an erroneous database;
- retrieving a SPUFI code that corresponds to the actual database;
- testing the SPUFI code using the erroneous database;
- determining whether the testing is successful; and

- updating the actual database based on the determining, the updating creating an a changed database.

The Hornibrook patent and the instant application were, at the time that the invention was made, owned by, or subject to an obligation of assignment to the same person. 35 U.S.C.§ 103(c) states:

> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The instant application was filed on or after December 5, 2001. The Hornibrook patent qualifies as prior art only under 35 U.S.C. § 102(e). The instant application and the Hornibrook patent were commonly owned or subject to an obligation of assignment to the same person at the time the invention was made. Therefore, the Hornibrook patent cannot be used in a 35 U.S.C. § 103 rejection to preclude patentability.

The remaining cited reference, Isip, does not teach or suggest all the limitations of Applicant's amended claim 1. Therefore, amended claim 1 is not anticipated by Isip and, accordingly, amended claim 1 is allowable over Isip. Claim 8 as amended is an information handling system claim including the same limitations of amended claim 1 and, therefore, is allowable for the same reason as amended claim 1. Claim 14 as amended is a computer program product claim including the same

limitations of amended claim 1 and, therefore, is allowable for the same reason as amended claim 1.

Claims 7 and 20 depend upon independent claims 1 and 14, respectfully, and are therefore allowable for the same reasons as independent claims 1 and 14.

Isip in view of Young

Claims 5, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isip in view of Young et al. (hereinafter "Young"). Applicant respectfully traverses these rejections. As a note, the Office Action states that Young is U.S. Publication No. 2003/0,028,555, but Applicant assumes that Young is actually U.S. Publication No. 2003/028,555.

Notwithstanding the fact that claims 5, 12, and 18 are dependent upon claims 1, 8, and 14, respectively, and therefore allowable for the same reasons as claims 1, 8, and 14 as discussed above, Applicant respectfully asserts that Applicant completed and reduced to practice Applicant's claimed invention before the filing date of Young. A declaration, pursuant to 37 C.F.R. § 1.131, has been duly executed by Applicant John Kliewe and is included with this Response. Mr. Kliewe declares that Applicant's claimed invention was completed and reduced to practice prior to July 31, 2001. Exhibit "A" to Mr. Kliewe's declaration is an Information Document that was entered into an IBM Problem Log Database, and which contained developer instructions for using Applicant's claimed invention. This Information Document was entered into the IBM Problem Log Database prior to July 31, 2001. Exhibit "B" to Mr. Kliewe's declaration is an IBM Invention Disclosure Form that disclosed Applicant's claimed

invention. This Disclosure was submitted to the IBM Intellectual Property Law Department in Austin, Texas prior to July 31, 2001. Mr. Kliewe's declaration under 37 C.F.R. § 1.131, therefore, removes the Young publication from consideration as prior art. Because, for the aforesaid reasons, the Young publication is not prior art with respect to Applicant's claimed invention, Applicant respectfully assert that claims 5, 12, and 18 are therefore allowable under 35 U.S.C. § 102(e).

Isip in view of Lloyd

Claims 2, 9, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isip in view of Lloyd (U.S. Pat. No. 6,460,041, hereinafter "Lloyd"). Applicant respectfully traverses these rejections. Claims 2, 9, and 15 depend upon amended independent claims 1, 8, and 14, respectfully, and are therefore allowable for the same reasons as amended independent claims 1, 8, and 14 as discussed above.

Isip in View of Lloyd and Further in View of Nakano

Claims 3, 10, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isip in view of Lloyd and further in view of Nakano et al. (U.S. Pat. No. 6,505,212, hereinafter "Nakano"). Applicant respectfully traverses these rejections. Claims 3, 10, and 16 depend upon amended independent claims 1, 8, and 14, respectfully, and are therefore allowable for the same reasons as amended independent claims 1, 8, and 14 as discussed above.

Isip in View of Brodersen

Claims 6, 13, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isip in view of Brodersen et al. (hereinafter "Brodersen"). Applicant respectfully traverses these rejections. As a note, the Office Action states that Brodersen is U.S. Patent No. 6,189,010 but, based upon the Office Action's Notice of References Cited, Applicant assumes that Brodersen is actually U.S. Patent No. 6,446,089.

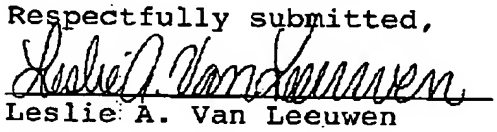
Claims 6, 13, and 19 depend upon amended independent claims 1, 8, and 14, respectfully, and are therefore allowable for the same reasons as amended independent claims 1, 8, and 14 as discussed above.

CONCLUSION

As a result of the foregoing, it is asserted by Applicant that the amended claims in the Application are in condition for allowance, and Applicant respectfully requests an early allowance of such claims.

Applicant respectfully requests that the Examiner contact the Applicant's attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By 

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